

Attorney's Docket No.: 15437-0112

In Re the Application of: Sharon S. Liu, et al.
(inventor(s))

Application No.: 09/483,724

Filed: January 14, 2000

For: MECHANISM FOR DYNAMICALLY CONSTRUCTING CUSTOMIZED IMPLEMENTATIONS
TO ENFORCE RESTRICTIONS

(title)

Group Art Unit: 2131

Examiner: Odaiche T. AKPATI

**NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES**

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir: Applicant(s) hereby appeal(s) to the Board of Patent Appeals and Interferences from the decision dated April 7, 2004 of the Examiner rejecting claims 1, 3-22, 24-43 and 45-66.

The item(s) checked below are appropriate:

XXX The following is the Notice of Appeal fee under 37 C.F.R. § 1.17(b):

X a. other than small entity: fee \$ 340.00

b. small entity: fee \$ 165.00

verified statement attached

verified statement was filed _____

XXX Extension of Time under 37 C.F.R. § 1.136(a) (one month) for reply to the rejection is requested.

A check for the fee for the extension of time is enclosed.

XXX Enclosed is a check in the amount of \$ 450.00 for the Notice of Appeal fee and one month extension of time.

4/12/2004 MHMEDI 00000053 09483724

1 FC:1401 340.00 0P

4/12/2004 MHMEDI 00000053 09483724

1 FC:1251 110.00 0P

-1-

Adjustment date: 04/27/2005 SDIRETAL1 00000001 501302 09483724
03/09/2005 DHALLI 00000001 840.00 CR
01 FC:1253

02/09/2005 DHALLI 00000001 501302 09483724
01 FC:1253 840.00 DR

Adjustment date: 04/27/2005 SDIRETAL1 00000003 09483724 -110.00 OP
10/12/2004 MHMEDI 00000003 09483724
02 FC:1251

Ref: 04/27/2005 SDIRETAL1 0011081800
DA#:
Name/Number: 09483724
\$110.00 CR
FC: 9204

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Sharon S. Liu, et al. :
Serial No.: 09/483,724 : Group Art Unit: 2131
Filed: February 14, 2000 : Examiner: Odaiche T., AKPATI
:
For: MECHANISM FOR DYNAMICALLY CONSTRUCTING CUSTOMIZED
IMPLEMENTATIONS TO ENFORCE RESTRICTIONS

REQUEST FOR REFUND

Mail Stop 16
Director of the US Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is believed that the U.S. Patent and Trademark Office should reimburse us \$840.00 as listed on our Deposit Account 50-1302 for an extension fee for response within the third month, as well as \$110.00 one month extension fee that we paid when filing a Notice of Appeal on October 7, 2004.

A Final Office Action with a mailing date April 7, 2004 was received for the above-identified patent application. Consequently, a reply to the Final Office Action was filed on May 17, 2004. Thus, the reply was filed within two months of the mailing date of the Final Office Action (*copy of (i) return receipt postcard, (ii) no fee transmittal; and (iii) Response Pursuant to 37 C.F.R. §1.116 enclosed*). Therefore, the shortened statutory period could not end earlier than the mailing date of an Advisory Action.

As of October 6, 2004, neither an Advisory Action nor a Notice of Allowance had been received. A Notice of Appeal was filed on October 6, 2004 (*copy of (i) return receipt postcard, (ii) check no. 5096 for \$450.00 for Notice of Appeal and One Month Extension of time, and (iii) Notice of Appeal Transmittal*). With the Notice of Appeal, a one month extension of time fee (\$110.00) was paid.

The Advisory Action with a mailing date October 21, 2004 was later received.

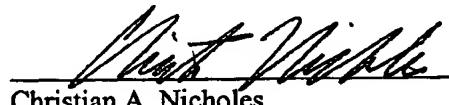
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It is now clear that that the Advisory Action was put in the mail AFTER the Notice of Appeal was filed. Therefore, no extension fees should have been required, and we should be reimbursed not only the \$840.00 that was listed on our Deposit Account for an extension fee within the third month, but also the \$110.00 one month extension fee that was paid unnecessarily with the Notice of Appeal on October 6, 2004.

It is requested that the amount of \$950.00 be refunded and credited to Deposit Account No. 50-1302 in the referenced patent application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Christian A. Nicholes

Reg. No. 50,266

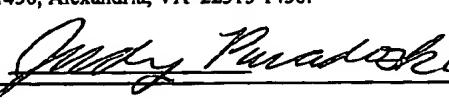
Date: March 4, 2005

2055 Gateway Place, Suite 550
San Jose, California 95110-1089
Tel: (408) 414-1080
Fax: (408) 414-1076

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on March 7, 2005

by 

Acknowledgment Receipt

Mailing Date: May 17, 2004
Attorney Docket No. 15437-0112
Serial No.: 09/483,724
Inventor(s): Sharon Liu, et al.
Title: MECHANISM FOR DYNAMICALLY CONSTRUCTING CUSTOMIZED
IMPLEMENTATIONS TO ENFORCE RESTRICTIONS

Attorney: CAN/jn
First Class Mail

Documents Enclosed:

- 1) No Fee Transmittal (1 pg) (in duplicate)
- 2) Response Pursuant to 37 C.F.R 1.116 (8 pgs)
- 3) Return Acknowledgment Postcard

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P4552NP

Acknowledgment Receipt

Mailing Date: May 17, 2004
Attorney Docket No. 15437-0112
Serial No.: 09/483,724
Inventor(s): Sharon Liu, et al.
Title: MECHANISM FOR DYNAMICALLY CONSTRUCTING CUSTOMIZED
IMPLEMENTATIONS TO ENFORCE RESTRICTIONS

Attorney: CAN/jn
First Class Mail

Documents Enclosed:

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- 2) Response Pursuant to 37 C.F.R 1.116 (8 pgs)
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no date docketed*

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NO FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.
Small Entity payments must be supported by a small entity statement,
otherwise large entity fees must be paid. See Forms PTO/SB/09-12.
See 37 C.F.R. §§ 1.27 AND 1.28

TOTAL AMOUNT OF PAYMENT (\$0.00)

Complete if Known

Application Number	09/483,724
Filing Date	January 14, 2000
First Named Inventor	Sharon S. Liu
Examiner Name	AKPATI, ODAICHE T.
Group/Art Unit	2131
Attorney Docket No.	15437-0112

METHOD OF PAYMENT (check one)

1. Throughout the pendency of this application, please charge any additional fees, including any required extension of time fees, and credit all overpayments to deposit account 50-1302. A duplicate of this sheet is enclosed.

Deposit Account Number

50-1302

Deposit Account Name

Hickman Palermo Truong & Becker, LLP

2. Payment Enclosed:

Check Money Order Other

3. Applicant(s) is entitled to small entity status.

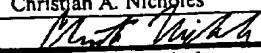
See 37 CFR 1.27.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051	130	2051 65 Surcharge - late filing fee or oath	
1052	50	2052 25 Surcharge - late provisional filing fee or cover sheet	
1053	130	1053 130 Non-English specification	
1812	2,520	1812 2,520 For filing a request for reexamination	
1804	920*	1804 920* Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805 1,840* Requesting publication of SIR after Examiner action	
1251	110	2251 55 Extension for reply within first month	
1252	420	2252 210 Extension for reply within second month	
1253	950	2253 475 Extension for reply within third month	
1254	1,480	2254 740 Extension for reply within fourth month	
1255	2010	2255 1005 Extension for reply within fifth month	
1401	330	2401 165 Notice of Appeal	
1402	330	2402 165 Filing a brief in support of an appeal	
1403	290	2403 145 Request for oral hearing	
1451	1,510	1451 1,510 Petition to institute a public use proceeding	
1452	110	2452 55 Petition to revive - unavoidable	
1453	1330	2453 665 Petition to revive - unintentional	
1501	1330	2501 665 Utility issue fee (or reissue)	
1502	480	2502 240 Design issue fee	
1503	640	2503 320 Plant issue fee	
1460	130	1460 130 Petitions to the Commissioner	
1807	50	1807 50 Petitions related to provisional applications	
1808	180	1806 180 Submission of Information Disclosure Stmt	
8021	40	8021 40 Recording each patent assignment per property (times number of properties)	
1809	770	2809 385 Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810 385 For each additional invention to be examined (37 CFR § 1.129(b))	
Other fee (specify) _____			
Other fee (specify) _____			
*Reduced by Basic Filing Fee Paid			SUBTOTAL (3) (\$0.00)

SUBMITTED BY

Name (Print/Type)	Christian A. Nicholes	Registration No. (Attorney/Agent)	50,266	Telephone	(408) 414-1080
Signature				Date	May 17, 2004

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Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Amend, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Sharon S. Liu, et al.

Serial No.: 09/483,724

Filed: January 14, 2000

Confirmation No.: 8756

Group Art Unit No.: 2131

Examiner: AKPATI, ODAICHE T.

For: MECHANISM FOR DYNAMICALLY
CONSTRUCTING CUSTOMIZED
IMPLEMENTATIONS TO ENFORCE
RESTRICTIONS

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE PURSUANT TO 37 C.F.R. § 1.116

Sir:

This is in response to the Final Office Action mailed April 7, 2004, the shortened statutory period for which runs until July 7, 2004.

There are no amendments. Remarks are presented on separate sheets below.

REMARKS

Reconsideration of the application in view of the following remarks is respectfully requested. Claims 1, 3-22, 24-43, and 45-66 are currently pending in the application.

CLAIMS 1, 3-16, 22, 24-37, 43, AND 45-58

The Office Action rejected Claims 1, 3-16, 22, 24-37, 43, and 45-58 under 35 U.S.C. §102(e) as being anticipated by Elgamal et al. (U.S. Patent No. 6,389,534 B1). The rejection is traversed.

With regard to Claim 1, there is recited a method performed by a framework in a system comprising the framework and at least one application; that method comprising:

receiving a request from the application for a customized implementation of a service;
determining a set of zero or more restrictions to be imposed upon said customized implementation;
dynamically constructing said customized implementation, said customized implementation incorporating said restrictions, and comprising enforcement logic for enforcing said restrictions; and
providing said customized implementation to the application;
wherein said customized implementation is invocable by the application without further interaction with the framework.

(emphasis added).

As discussed in the response to the previous Office Action ("the previous response"), the method of Claim 1 is quite advantageous because it allows an application to obtain access to services without repeatedly requesting those services from some centralized framework.

Also as discussed in the previous response, Elgamal does not disclose, teach, or suggest such a method. As discussed in the previous response, Elgamal fails to disclose,

teach, or suggest the limitation of "wherein said customized implementation is invocable by the application without further interaction with the framework."

The Final Office Action alleges that "Elgamal's Fig. 3 and further elaboration on column 6, lines 11-31 shows that the application does not have to return to the framework every time it needs to request an allowed operation or service." The Final Office Action further alleges, "A filtered list is returned to the application (column 6, lines 26-29) and hence, the application does not need to go back and call the framework to repeat this process whenever it needs to request an operation regarding a cryptographic function within the uploaded filtered list."

However, even assuming, arguendo, that a filtered list is returned to the application of Elgamal, it does not necessarily follow from this assertion that the application does not need to go back and call the framework whenever the application needs to request an operation regarding a cryptographic function within the uploaded filtered list. Quite to the contrary, the very last sentence of the text cited by the Final Office Action reads, "With the list of filtered (or authorized) cipher suites, the application causes a cryptographic operation to be performed **in accordance with FIG. 4.**" (Col. 6, lines 29-31; emphasis added).

Thus, to understand how the application of Elgamal causes a cryptographic operation to be performed, reference must be made to Elgamal's FIG. 4 and the accompanying description. In col. 6, lines 32-43, Elgamal states:

Referring now to FIG. 4, the cryptographic operation is initiated by an application at step 401. **The application calls a service module to request an operation involving cryptographic functions at step 402.** At step 403, the service module calls its corresponding policy filter to determine whether the called operation is allowed. At step 404, **if the called operation is not approved by the corresponding policy filter, then the service module returns an error to the application at step 405.** On the other hand, **if, at step 404, the called operation is approved, then**

at step 406, the service module performs the called operation, calling the cryptographic module as necessary. Thereafter, the service module, at step 407, returns the operation results to the application.

(emphasis added).

Contrary to the Final Office Action's assertions, the above text makes it clear that even though a filtered list might be returned to the application of Elgamal, the application of Elgamal actually **does** need to go back and call the alleged framework whenever the application needs to request an operation regarding a cryptographic function. From the Final Office Action, it appears that the "service module" of Elgamal is being analogized with the "framework" of Claim 1. That being the case, the above text indicates that, even with the list of filtered cipher suites, the application of Elgamal always calls the service module whenever the application requests an operation involving cryptographic functions.

Thus, according to the Final Office Action's analogy and the above text, the application of Elgamal always calls the alleged framework (i.e., service module) whenever the application requests an operation involving cryptographic functions, thereby further interacting with the alleged framework. Therefore, Elgamal does not disclose, teach, or suggest the limitation of "wherein said customized implementation is invocable by the application **without further interaction with the framework**" as required by Claim 1.

Additionally, the above text makes it clear that the service module of Elgamal returns either an "error" or "operation results" to the application of Elgamal. As explained in the previous response, neither an "error" nor "operation results" is the same as a "customized implementation of a service" as required by Claim 1. Unlike the customized implementation of Claim 1, which is "invocable by the application without

further interaction with the framework,” neither an “error” nor “operation results” can even be invoked.

For at least these reasons, Applicants submit that Elgamal does not anticipate Claim 1.

Claim 22 is a device claim analogous to the method of Claim 1. Claim 43 is a computer-readable medium claim analogous to the method of Claim 1. Applicants submit that, for at least the reasons given above in connection with Claim 1, Elgamal does not anticipate Claims 22 and 43.

CLAIMS 17-21, 38-42, AND 59-63

The Office Action rejected Claims 17-21, 38-42, and 59-63 under 35 U.S.C. §103(a) as being unpatentable over Elgamal in view of Schell et al. (U.S. Patent No. 5,933,503). The rejection is respectfully traversed.

Claims 17, 38, and 59 depend from Claims 1, 22, and 43, respectively. Therefore, Claims 17, 38, and 59 contain the limitations of Claims 1, 22, and 43, respectfully.

As explained above, Elgamal does not disclose, teach, or suggest the limitation “wherein said customized implementation is invocable by the application without further interaction with the framework.” Thus, Claims 17, 38, and 59 are patentable over Elgamal, taken individually.

Schell also fails to disclose, teach, or suggest the limitation “wherein said customized implementation is invocable by the application without further interaction with the framework.” Indeed, the Office Action relies only upon Elgamal to disclose this limitation. The Office Action does not even allege that Schell discloses or suggests this limitation. Thus, Claims 17, 38, and 59 are patentable over Schell, taken individually.

Even assuming, arguendo, that it would have been obvious to combine Elgamal and Schell, the combination of Elgamal and Schell still fails to disclose, teach, or suggest the limitation “wherein said customized implementation is invocable by the application without further interaction with the framework” as contained in Claims 17, 38, and 59. Accordingly, Applicants submit that Claims 17, 38, and 59 are patentable over Elgamal and Schell.

CLAIMS 64-66

The Office Action rejected Claims 64-66 under 35 U.S.C. §103(a) as being unpatentable over Elgamal in view of Chan et al. (U.S. Patent No. 6,005,942). The rejection is respectfully traversed.

Claims 64, 65, and 66 depend from Claims 1, 22, and 43, respectively. Therefore, Claims 64, 65, and 66 contain the limitations of Claims 1, 22, and 43, respectfully.

As explained above, Elgamal does not disclose, teach, or suggest the limitation “wherein said customized implementation is invocable by the application without further interaction with the framework.” Thus, Claims 64-66 are patentable over Elgamal, taken individually.

Chan also fails to disclose, teach, or suggest the limitation “wherein said customized implementation is invocable by the application without further interaction with the framework.” Indeed, the Office Action relies only upon Elgamal to disclose this limitation. The Office Action does not even allege that Chan discloses or suggests this limitation. Thus, Claims 64-66 are patentable over Chan, taken individually.

Even assuming, arguendo, that it would have been obvious to combine Elgamal and Chan, the combination of Elgamal and Chan still fails to disclose, teach, or suggest

the limitation "wherein said customized implementation is invocable by the application without further interaction with the framework" as contained in Claims 64-66.

Accordingly, Applicants submit that Claims 64-66 are patentable over Elgamal and Chan.

Additionally, the portion of Chan cited in the Final Office Action refers to the "JAVA Card standard," rather than the "Java Cryptography Extension to Java Platform" recited in Claims 64-66. The "JAVA Card standard" is **not the same** as the "Java Cryptography Extension to Java Platform" recited in Claims 64-66. Thus, Claims 64-66 are patentable over Chan, taken individually.

The Final Office Action admits that Elgamal does not disclose, teach, or suggest a framework that comprises the Java Cryptography Extension to Java Platform as required by Claims 64-66. Thus, Claims 64-66 are also patentable over Elgamal, taken individually.

Even assuming, arguendo, that it would have been obvious to combine Elgamal and Chan, the combination of Elgamal and Chan still fails to disclose, teach, or suggest a framework that comprises the Java Cryptography Extension to Java Platform as required by Claims 64-66. Accordingly, Applicants submit that Claims 64-66 are patentable over Elgamal and Chan.

REMAINING DEPENDENT CLAIMS

The pending claims not discussed so far are dependent claims that depend on an independent claim that is discussed above. Because each of the dependent claims includes the limitations of claims upon which they depend, the dependent claims are patentable for at least those reasons the claims upon which the dependent claims depend are patentable. Removal of the rejections with respect to the dependent claims and

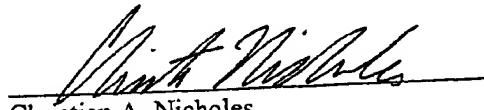
allowance of the dependent claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

For at least the reasons set forth above, Applicants respectfully submit that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER
LLP

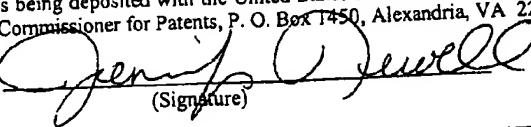
Dated: May 17, 2004


Christian A. Nicholes
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Facsimile No.: (408) 414-1076

CERTIFICATE OF MAILING

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Attorney: CAN/jp
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Mailing Date: October 6, 2004
Attorney Docket No. 15437-0112
Serial No.: 09/483,724
Inventor(s): Sharon S. Liu, et al.
Title: MECHANISM FOR DYNAMICALLY CONSTRUCTING CUSTOMIZED
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ENTRY

HICKMAN PALERMO TRUONG & BECKER LLP
PTO PAYMENT ACCOUNT
1600 WILLOW STREET
SAN JOSE, CA 95125

HERITAGE BANK OF COMMERCE
SAN JOSE, CA 95113

80-4228/1211

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Oct. 6 2004
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XXX If any additional fee is required, please charge Deposit Account No. 50-1302. A duplicate of this sheet is enclosed for Deposit Account charging purposes.

HICKMAN PALERMO TRUONG & BECKER LLP

Date: October 6, 2004

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Christian A. Nicholes
Reg. No. 50,266

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on October 6, 2004
Date of Deposit

Judy Paradoski

Name of Person Mailing Correspondence


Judy Paradoski
Signature

October 6, 2004

Date

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